



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Lawrence W. Krebs et al

Serial No. 09/110,661

Filed: July 7, 1998

For: ATM NETWORK MANAGEMENT SYSTEM

Group Art Unit 2762

Examiner B. Phunkulh

2661

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3-5-03
P.Z.

APPEAL BRIEF TRANSMITTAL

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Technology Center 2600

Hon. Commissioner of Patents and Trademarks
Washington, D. C. 20231

Sir:

Attached hereto are three (3) copies of the BRIEF ON APPEAL for the above-identified application.

Also attached is our check in the amount of \$320.00 in payment of the brief fee as provided by 37 C.F.R. 1.17(f). Any additional fees necessary to effect the proper and timely filing of this Brief may be charged to Deposit Account No. 26-0090.

Petition is hereby made to the Commissioner of Patents and Trademarks to extend the period for filing this Brief on Appeal for one month, so as to expire February 27, 2003. A check in the amount of \$110.00 for this extension is also attached.

Respectfully submitted,

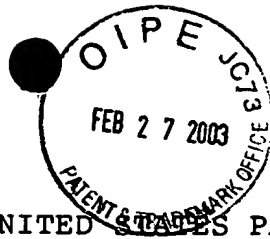
Jim Zegeer, Reg. No. 18,957
Attorney for Appellants

Attachments: Brief on Appeal
Checks (2) - \$320.00 (Brief) and \$110.00 (Extension)

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Date: February 27, 2003

In the event this paper is deemed not timely filed, the applicant hereby petitions for an appropriate extension of time. The fee for this extension may be charged to Deposit Account No. 26-0090 along with any other additional fees which may be required with respect to this paper.



Attorney File: 2779-Z

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BRIEF ON APPEAL

Hon. Commissioner of Patents & Trademarks
Washington, D. C. 20231

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Sir:

This is an appeal from the decision of the Primary Examiner dated August 27, 2002 finally rejecting Claims 1 and 2 of the above-identified application.

I. The Real Party in Interest

The real party in interest is ITT Manufacturing Enterprises, Inc.

II. Related Appeals and Interferences

There are no related appeals or interferences.

III. Status of the Claims

Claims 1 and 2, the only claims pending in the application, have been finally rejected.

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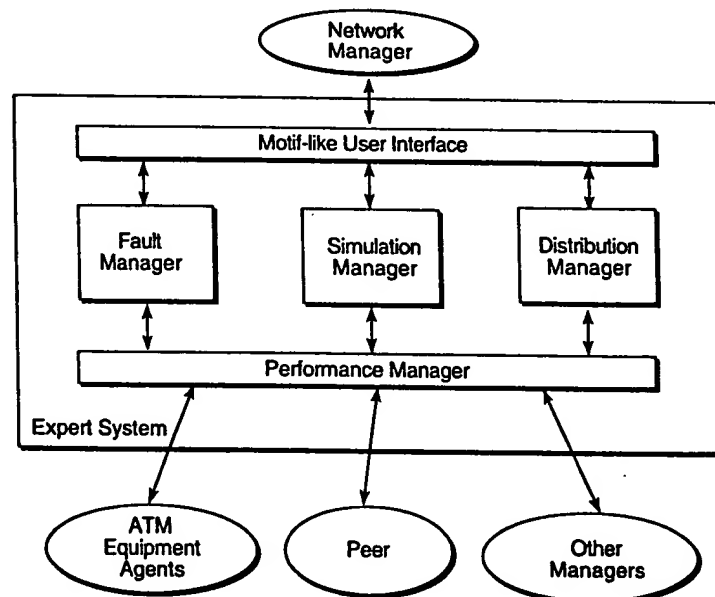
IV. Status of the Amendments

There were no amendments filed following the final rejection.

V. Summary of the Invention

The single drawing in the application is reproduced below for convenience of reference:

FIG. 1



The invention is directed to an asynchronous transfer mode (ATM) management network having fault management, performance management, configuration management, security management and accounting management functions and is directed to the method of operating the system using an inference engine fault manager including correlation of ATM switch failures and traps and automated courses of action and using an inference engine for the performance management of the ATM management network.

Thus, the invention focuses on two areas of network management: fault management and performance management. The inference engine allows the system to build a set of values for acting upon false alarms generated within the ATM network. The rules provide a level of intelligence and lets users be proactive in the management of their networks rather than to act on a set of individual faults, alarm or message. The system's intelligence correlates these events and recommends a corrective action. Moreover, the invention has the ability to support multiple vendors' ATM switches and incorporates sophisticated intelligence (expert system) into the system's inference engine for heterogeneous ATM environments.

VI. Issues

The issue presented in this case is whether the Examiner was correct in rejecting Claims 1 and 2 under 35 U.S.C. §103(a) as being anticipated by Hearn et al (US 5,640,505) (hereinafter "Hearn") in view of Admitted Prior Art (hereinafter "APA").

VII. Grouping of Claims

The claims stand or fall together.

VIII. Argument

Appellants respectfully submit that the Examiner's rejection of Claims 1 and 2 under 35 U.S.C. §103(a) as being unpatentable over Hearn in view of APA is erroneous.

To establish obviousness based on a combination of references, there must be some motivation, suggestion, or teaching of the desirability of making the combination. *In re Kotzab*, 55 USPQ2d, 1313 (Fed. Cir. 2000). The existence of this motivation to combine is a question of fact. *Winner Intern. Royalty Corp. v. Wang*, 202 F.3d 1340, 1348, 53 USPQ2d (BNA) 1580 (Fed. Cir. 2000). The motivation may come expressly or implicitly from the prior art, from the knowledge of persons of ordinary skill, or from the nature of the problem to be solved. The finding of obviousness must be supported by factual findings that explain why the person of ordinary skill would have selected the elements of the cited references and combined them to make the claimed invention.

The Federal Circuit has explained that the requirement of a motivation to combine is necessary to prevent findings of obviousness based improperly on "the subtle but powerful attraction" of hindsight reconstruction. *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 664-64, 57 USPQ2d (BNA) 1161 (Fed. Cir. 2000). In *Ruiz*, the Federal Circuit was unable to determine where the district court had found the required motivation to combine the prior art references to arrive at the claimed invention. In particular, the district court did not explain why a person of

ordinary skill would refer to prior art methods that appeared to solve different problems, or why it would have been obvious to combine two references that had both been available for many years before the claimed invention was made. Each of these facts tended to imply that the invention was not obvious.

The Federal Circuit also found no motivation to combine references in *Ecolochem, Inc. v. Southern California Edison Co.*, 56 USPQ2d (BNA) 1065 (Fed. Cir. 2000), where the patented invention was a high purity water treatment process. The primary reference that the accused infringer relied on to show obviousness was widely regarded in the relevant industry as too impractical for use on a large scale or for large volumes or for obtaining high purity deoxygenated water.

Apart from the fact that the Hearn reference fails to disclose or teach the steps a) and b) in appellants' Claim 1, there is no suggestion or no motivation disclosed or taught and suggested to combine the references in the manner suggested by the Examiner.

FIG. 1

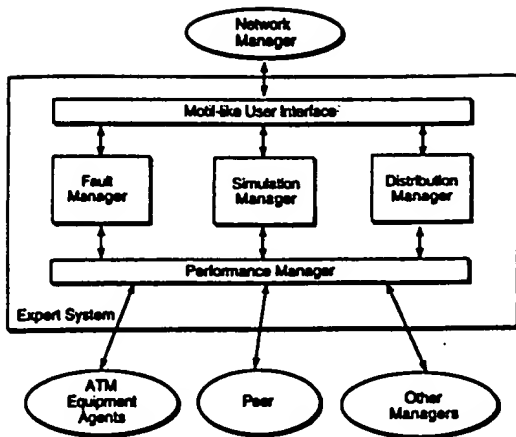


Fig.2.

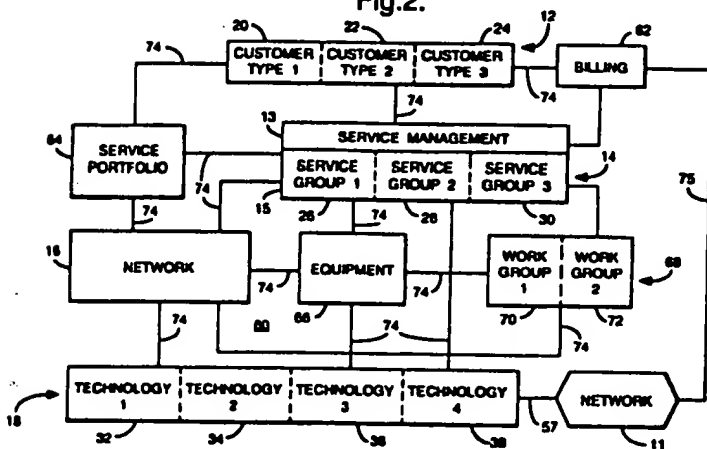
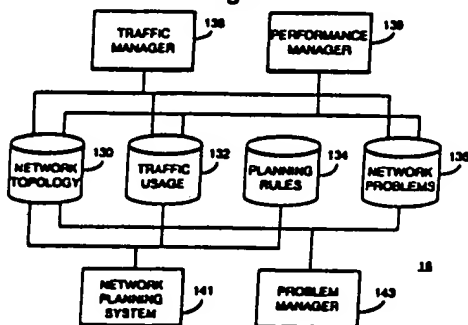


Fig.5.



The single drawing in this application and Figures 2 and 5 of Hearn are reproduced (in reduced and colocated form) to the left hereof for convenience of reference. Note that applicants' Jepson preamble requires that the ATM management network include functional areas, including security management and accounting management. The claim also includes the steps of using an inference engine fault manager including correlation of ATM switch failures and traps and automating recommended courses of corrective action and using an inference engine for the performance management of an ATM management network. The Examiner contends that Hearn discloses a problem manager 143 (which the Examiner equates to applicants' fault manager) for receiving

fault reports from the other domains, using information contained in the database 130 concerning the network topology. It then correlates these faults and identifies the problems which are causing them. The identified problems are recorded in the database 136, and the manager 143 sends instructions (recommendation) to the traffic manager 138, the service domain 14 or the traffic domain 18 to restore lost services and to remove problems (the Examiner referring to Figs 2 and 5 (reproduced above) and col. 1, lines 21-34).

Neither the problem manager nor the traffic manager nor the performance manager of Hearn is characterized as being either an expert system or an inference engine. Hence, it is not clear that the reference utilizes an inference engine fault manager including correlation of ATM switch failures and traps and automating recommended courses of corrective action or that there is an inference engine used for the performance management of the ATM management network. In fact, the terms "inference" and "expert" do not appear in the Hearn disclosure.

Appellants' Jepson Claim 1 is relatively short and is repeated as follows:

1. In an asynchronous transfer mode (ATM) management network, having the following functional areas: fault management, performance management, configuration management, security management and accounting management, the method of operating said ATM management network comprising:

(a) using an inference engine fault manager including correlation of ATM switch failures and traps and automating recommend courses of corrective action, and

(b) using an inference engine for said performance management of said ATM management network.

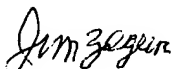
It is appellants' position that neither step (a) nor step (b) is disclosed in the Hearn reference and that the Examiner's reading of the reference is faulty in this regard.

Note that the method of operating the ATM management network includes two inference engine steps, neither of which is taught by the Hearn reference. It is only by inference and use of hindsight inference -- at best -- as the Examiner arrived at appellants' Claim 1. The Examiner has not supplied any reasoning or logic to explain why one skilled in the art would, apart from appellants' specification and claims, arrive at the obviousness conclusion that the Examiner did.

CONCLUSION

In view of the above, it is clear that the Examiner erred in rejection Claims 1 and 2 for obviousness and should be reversed.

Respectfully submitted,


Jim Zegeer, Reg. No. 18,957
Attorney for Appellants

Attachment: APPENDIX (Claim on appeal)

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APPENDIX

1. In an asynchronous transfer mode (ATM) management network, having the following functional areas: fault management, performance management, configuration management, security management and accounting management, the method of operating said ATM management network comprising:

(a) using an inference engine fault manager including correlation of ATM switch failures and traps and automating recommend courses of corrective action, and

(b) using an inference engine for said performance management of said ATM management network.

2. In an asynchronous transfer mode (ATM) management network method defined in claim 1 including providing sophisticated diagnostics of fault and performance management for multivendor ATM networks.